REMARKS/ARGUMENTS:

Claims 19-46, 49-50, and 61-66 and 71-75 are currently pending in the application. No claims stand allowed. Claims 19, 22, 32, 61, and 72 have been amended. No new matter has been added. Support for the amendments may be found in the specification at, for example, page 14, lines 19-33, and page 32, lines 14-33.

First Action Final Rejection

The outstanding Office Action, dated December 22, 2009, is a first action final rejection issued in response to Applicant's previous reply, which was filed with an RCE on September 28, 2009. Applicant respectfully submits that the outstanding Office Action should not have been made final because the claims would not have been properly finally rejected on the grounds of record in the next Office action if they had been entered in the application prior to the filing of the RCE. See MPEP 706.07(b). The rejections of at least claim 32 under 35 U.S.C. 102(e) over Wells '634, Wells '836, and Joshi (in the alternative) did not establish a prima facie case of anticipation, because neither Wells '634 nor Wells '836 nor Joshi teaches every element of claim 32.

The standard for anticipation is set out in MPEP 2131, "To anticipate a claim, the reference must teach every element of the claim," (emphasis added). "The identical invention must be shown in as complete detail as is contained in the... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1020 (Fed. Cir. 1989), cited in MPEP 2131. In a recent case, the Court of Appeals for the Federal Circuit stated:

> Section 102 embodies the concept of novelty – if a device or process has been previously invented (and disclosed to the public), then it is not new, and therefore the claimed invention is 'anticipated' by the prior invention. As we have stated numerous times (language on which VeriSign relies), in order to demonstrate anticipation, the proponent must show 'that the four corners of a single, prior art document describe every element of the claimed invention." Xerox, 485 F.3d at 1322... Because the hallmark of anticipation is prior invention, the prior art reference – in order to anticipate under 35 USC § 102 – must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements 'arranged as in the claim.' Connell v. Sears Roebuck & Co., 772 F.2d 1542, 1548 (Fed. Cir. 1983).
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> Net Moneyin, Inc v. Verisign, 2007-1565 (Fed. Cir. 2008)

Wells '634 does not disclose or suggest monitoring game performance including coin-in of a first game played on a gaming machine, checking at least one update trigger, wherein the at least one update trigger comprises a game event, a game performance event, a player input, or a combination thereof, and determining that a configuration update has been triggered based upon

at least the update triggers and the game performance of the first game, as recited in claim 32. Instead, Wells '634 discloses, for example, downloading software to add new features, update programming, negotiation, data transfer, verification, hardware configurations, verifying that the information to be downloaded is appropriate for the target device, and controlling transactions using an information file. These features of Wells '634 do not describe the aforementioned features of claim 32.

Wells '836 does not disclose or suggest monitoring game performance including coin-in of a first game played on a gaming machine, checking at least one update trigger, wherein the at least one update trigger comprises a game event, a game performance event, a player input, or a combination thereof, and determining that a configuration update has been triggered based upon at least the update triggers and the game performance of the first game, as recited in claim 32. Wells '836 discloses, for example, downloading programs for gaming devices, selecting a most recent software version, hardware configurations, use of a download terminal, validation of a jurisdiction, and determining what to download based on a customer order. These features of Wells '836 do not describe the aforementioned features of claim 32.

Joshi does not disclose or suggest when the configuration update has been triggered, identifying one or more game software components for the configuration update on the gaming machine that enable a **second game** to be played on the gaming machine, bundling the game software components, and sending the game software components to the gaming machine, wherein said game software components are used to present the **second game** on the gaming machine, as recited in claim 32. Rather, Joshi discloses that when "the controller 152 determines that a particular player appeal feature is the favorite of players, it then takes the necessary steps to inform a particular one of the gaming machines 154a-154e, which is not displaying or broadcasting the favorite visual and/or audio elements, to begin playing the favorite visual and/or audio element." Joshi, column 12, lines 43-59. Joshi's feature of "playing the favorite visual and/or audio element" is different from claim 32's features of identifying components that enable a **second game**, because visual and/or audio elements are not games as recited in claim 32, so there is no second game in Joshi for which components could be identified. Games are different from visual/audio elements for reasonable interpretations of the terms "games" and "visual/audio elements." Also, Joshi distinguishes visual and/or audio elements from games. Joshi states that "[s]everal pieces of trivia may be provided for each given day of the year and may be displayed via visual elements or broadcast via audio elements between games within the gaming machine

10." Joshi, column 11, line 66 through column 12, line 2. Joshi's characterization of visual/audio elements as being displayed "between games" indicates that visual/audio elements are different from games.

Further, although Joshi describes changing themes and/or pay tables, themes and pay tables are not the same as games in reasonable interpretations of the terms "themes" and "pay tables." Also, Joshi does not disclose changing themes when a configuration update has been triggered. Instead, Joshi discloses that themes and/or pay tables are changed as a function of time. For example, Joshi describes changing themes when a predetermined time is encountered (column 9, lines 15-17) and changing pay tables as a function of time (column 12, lines 16-17).

Since a prima facie case of anticipation of claim 32 has not been established in the record, the claims would not have been properly finally rejected on the grounds of record in the next Office action if they had been entered in the application prior to the filing of the RCE. Applicant therefore respectfully requests that the finality of the outstanding Office Action be withdrawn.

Claim rejections under 35 U.S.C. 102

Claims 19-46, 49-50, 61-66, and 71-72 are rejected under 35 U.S.C. 102(e) as allegedly being anticipated by Wells (6219836, 6488585, 6805634). These rejections are respectfully traversed.

None of the cited Wells references ('836, '585, or '634) describes or suggests a gaming system comprising a network server controller configured to identify **second game software components** when the condition is satisfied by the game performance data, wherein the second game software components enable a **second game** to be played on the gaming machine and are selected based upon the game **performance data** that satisfies the trigger, as recited in claim 19.

Wells '634 does not disclose or suggest a network server controller configured to determine that the condition of the at least one update trigger is satisfied by the game **performance data**, wherein the condition is satisfied when one or more of the **coin-in, coin-out, or amount bet per game** are within a predetermined range of values, as recited in claim 19. Instead, Wells '634 discloses, for example, downloading software to add new features, update programming, negotiation, data transfer, verification, hardware configurations, verifying that the information to be downloaded is appropriate for the target device, and controlling transactions using an information file. These features of Wells '634 do not describe or suggest determining

that the condition of the at least one update trigger is satisfied by the game **performance data** as recited in claim 19.

Wells '836 does not disclose or suggest the aforementioned features of claim 19, such as a network server controller configured to determine that the condition of the at least one update trigger is satisfied by the game **performance data**, wherein the condition is satisfied when one or more of the **coin-in, coin-out, or amount bet per game** are within a predetermined range of values. Instead, Wells '836 discloses, for example, downloading programs for gaming devices, selecting a most recent software version, hardware configurations, use of a download terminal, validation of a jurisdiction, and determining what to download based on a customer order. These features of Wells '836 do not describe or suggest determining that the condition of the at least one update trigger is satisfied by the game **performance data** as recited in claim 19.

As described above with reference to claim 32, Joshi does not disclose or suggest a gaming system comprising a network server controller configured to identify one or more game software components for the configuration update when the condition is satisfied by the game performance data, wherein the game software components enable a **second game** to be played on the gaming machine; bundle the game software components; and send the game software components to the gaming machine, wherein said game software components are used to present the second **game** on the gaming machine, as recited in claim 19. Rather, Joshi discloses that when "the controller 152 determines that a particular player appeal feature is the favorite of players, it then takes the necessary steps to inform a particular one of the gaming machines 154a-154e, which is not displaying or broadcasting the favorite visual and/or audio elements, to begin playing the favorite visual and/or audio element." Joshi, column 12, lines 43-59. Joshi's feature of "playing the favorite visual and/or audio element" is different from claim 19's features of identifying components that enable a second **game**, because visual and/or audio elements are not games as recited in claim 19, so there is no second game in Joshi for which components could be identified. Games are different from visual/audio elements for reasonable interpretations of the terms "games" and "visual/audio elements." Also, Joshi distinguishes visual and/or audio elements from games. Joshi states that "[s]everal pieces of trivia may be provided for each given day of the year and may be displayed via visual elements or broadcast via audio elements between games within the gaming machine 10." Joshi, column 11, line 66 through column 12, line 2. Joshi's characterization of visual/audio elements as being displayed "between games" indicates that visual/audio elements are different from games. Thus does not disclose or suggest a network server controller configured to identify second **game** software components when the condition is satisfied by the game performance data, wherein the second game software

components enable a second **game** to be played on the gaming machine and are selected based upon the game performance data that satisfies the trigger, as recited in claim 19.

For the aforementioned reasons, none of the cited references anticipates the features of claim 19, and the section 102 rejections of claim 19 should be withdrawn.

Claims 32, 40-42, 44, and 49-50 are rejected under 35 U.S.C. 102(e) as allegedly being anticipated by Joshi (6939226). This rejection is respectfully traversed.

For the reasons given above with reference to claim 32 and Joshi, Joshi does not disclose or suggest the features of claim 32, and the rejection of claim 32 should be withdrawn.

Claim rejections under 35 U.S.C. 103

Claims 19-22, 24, 36-31, 61, 63-66, and 71-72 are rejected under 35 U.S.C. 102(e) as being anticipated by Joshi or, in the alternative, under 35 U.S.C. 103(a) as obvious over Joshi in view of Pease (5759102). This rejection is respectfully traversed.

Joshi does not describe or suggest the features of claim 19 for at least the reasons given above with respect to the section 102 rejection of claim 19. Pease does not disclose or suggest a network server controller configured to determine that the condition of the at least one update trigger is satisfied by the game performance data, wherein the condition is satisfied when one or more of the coin-in, coin-out, or amount bet per game are within a predetermined range of values, as recited in claim 19. Further, Pease does not disclose or suggest when the configuration update has been triggered, identifying one or more game software components for the configuration update on the gaming machine that enable a second game to be played on the gaming machine, as recited in claim 19. Instead, Pease describes reprogramming peripheral devices of gaming terminals, and that programming information is downloaded to peripheral devices in such as way as to reduce or minimize the amount of down time or inconvenience to players. Pease, column 2, lines 13-55. Since Pease does not disclose the features that Joshi fails to disclose, Pease does not cure the deficiencies of Joshi, and the section 103 rejection of claim 19 should be withdrawn.

Independent claim 61 has been amended to recite similar features as claim 32. For reasons similar to those given above with respect to claim 32, Joshi does not disclose or suggest the features of claim 61. Pease also fails to disclose or suggest the features of amended claim 61. Neither Joshi nor Pease, considered alone or in combination, describes or suggests wherein the at least one update trigger further comprises one or more triggers that configure the gaming machine with at least one selected game at a selected time of day corresponding to the

preferences of a demographic group, wherein the demographic group comprises individuals who are more likely to play the at least one selected game at the selected time of day, as recited in amended claim 61. Accordingly, Applicant respectfully submits that the section 103 rejection of claim 61 should be withdrawn.

The remaining dependent claims incorporate, by virtue of their dependency, all of the features of the independent claims on which they are based. Therefore, Applicant respectfully submits that the rejections of these claims should be withdrawn for the same reasons as their respective independent claims.

Applicant believes that all pending claims are allowable and respectfully requests a Notice of Allowance for this application from the Examiner. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

Although the present communication may include alterations to the application or claims, or characterizations of claim scope, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations herein are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

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The Commissioner is hereby authorized to charge any additional fees, including any extension fees, which may be required or credit any overpayment directly to the account of the undersigned, No. 50-4480 (Order No. IGT1P042D1).

Respectfully submitted,
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